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09/465,418	12/16/1999	GEOFFREY B. RHOADS	60075	8844

23735 7590 09/26/2006

DIGIMARC CORPORATION  
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EXAMINER
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BALI, VIKKRAM

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/465,418  
Filing Date: December 16, 1999  
Appellant(s): RHOADS ET AL.

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William Y. Conwell  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/01/2005 appealing from the Office action mailed 8/29/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,269,169	FUNK et al.	7-2001
5,905,248	RUSSELL et al.	5-1999

6,131,718

WITSCHORIK

10-2000

Gruhl, et al. "Information Hiding to Foil the Casual Counterfeiter" MIT Media Laboratory,  
Proc. 2d Information Hiding Workshop, LNCS vol. 1525, pp. 1-15

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. The declaration does not provide evidence of commercial success. An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. See MPEP 716.03.

Evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition, improved performance, or some other factor. The declaration fails to establish the nexus. The method as detail by the press release in March 2004 (see page 24 of brief) fails to point out the method as claimed, i.e. there no factual evidence in that statement that the method claimed is the method in the press release. Also, the statement "their adoption of the technology ... of the claimed invention." merely states the opinion of the under signer of the brief and not the evidence of the commercial success as required by the MPEP.

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other

business events extraneous to the merits of the claimed invention, etc. In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); In re Noznick, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk et al (US 6269169) in view of Russell et al (US 5905248).

With respect to claim 1, Funk discloses a method for recognizing a security document (see col. 5, lines 35-38, wherein I states that the CPU determines "recognizes" as a document be a passport "security document"), and in response, directing to a web site related to the document (see col. 5 last line to col. 6 first two lines, it states that there is network port to connect to a central computer "web site" using a network port in order to call the document information "related to the document") as claimed. However, Funk fails to explicitly disclose a web browser, as claimed.

Russell, teaches a method for connecting to a web site using the web browser (see col. 2, lines 57-62) as claimed.

It would have been obvious to one ordinary skilled in the art at the time of invention to combine the two references as they are analogous, because they are solving the similar problem of connecting to a web site to gain the information regarding the document read by the scanner. The teachings of Russell of having the URL encoded in to the text can be implemented in to the security document of the Funk as the passport does has text and the scanner of the Funk does scan the text (figure 1 numerical 12). And, motivation of the combination does come from the teaching reference of Russell from col. 2, lines 34-39.

With respect to claim 2 and 3, Funk further discloses presenting a user with a substitute image (see col. 6, lines 4-6) and presenting a user with supplemental information relating to the security document to its permitted use, (see col. 6, lines 6-10) as claimed.

With respect to claim 4, Funk further discloses recognizing a security document by a digital watermark encoded therewith, (see col. 5, lines 30-35, it states that the passport has a MRZ sections and the information read from the MRZ sections "watermark" helps to identify or recognize the passport "security document") as claimed.

With respect to claim 5, Funk further discloses a computer storage medium having instruction stored thereon for causing a computer to perform the method of claim 1, (see CPU 14 if figure 1, the CPU does have a RAM to store the instruction to perform the method as detailed in claim 1) as claimed.

Claim 18 is rejected for the same reasons as set forth for the rejection of claim 1, because claim 18 is claiming similar subject matter as claim 1. furthermore, Funk discloses the information concerning reproduction of the document, (see col. 6, 8-9, it states that the central computer "web site" determine if the passport is alter or counterfeit "information concerning reproduction") as claimed.

With respect to claim 27, Funk further discloses recognizing is performed by a general purpose computer, (see figure 1) as claimed.

4. Claim 19, 23, 24, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk et al (US 6269169) in view of Russell et al (US 5905248) as applied to claim 18 above, and further in view of Information Hiding to Foil the Casual Counterfeiter", by Gruhl et al., (hereinafter Gruhl).

With respect to claim 19, Funk and Russell disclose the invention substantially as disclose and as describe above in claim 18. Gruhl teaches: web sites that provide information about counterfeiting and penalties (endnotes 11-13, page 15).

It would have been obvious to one of ordinary skill in the art to direct the user of a system like Funk and Russell to a website that not only confirms the validity of document or information about counterfeiting, but also allows the user to provide the would-be counterfeiter with potential penalties for continued passing of false currency. One of ordinary skill would be motivated to look at Funk and Russell in light of Gruhl since the system of Funk is used to provide information regarding the document scanned.

With respect to claim 23, Gruhl teaches: web sites that provide guidelines for legitimate use of security document images (endnotes 11-13, page 15).

With respect to claim 24, Gruhl teaches security document as a banknote, (see figure 5 on page 8) as claimed.

As per Claim 28, although Funk teaches using MRZ information areas (col. 5, lines 30-35) not steganographic data decoded using visible light. Gruhl teaches: wherein said recognizing includes decoding steganographically (imperceptibly embeds, page 3, section 2, second sentence) encoded data from visible light scan data (Gruhl is trying to solve the problems of using color copiers, page 2, Section entitled Problem), corresponding to said document( see fig 5, page 8).

It would have been obvious to one of ordinary skill in the art to use the imperceptible watermark of Gruhl in the system of Funk and Russell, as suggested by Funk (see col. 5, lines 42-50).

Regarding Claim 29, arguments analogous to those presented for Claims 19, 23 and 28 are applicable to Claim 29.

5. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funk et al (US 6269169) in view of Russell et al (US 5905248) as applied to claim 18 above, and further in view of Witschorik (US 6131718).

With respect to claims 25-26, Funk and Russell disclose the invention substantially as disclose and as describe above in claim 18. However, they fail to disclose recognizing is performed by a scanner and the by the driver software in the



scanner, as claimed. Witschorik in method of detecting counterfeit currency teaches recognizing is performed by a scanner and the by the driver software in the scanner, (see figure 1 numerical 50 the scanning devices and col. 8 lines 4-6) as claimed.

It would have been obvious to one ordinary skilled in the art at the time of invention to combine the references as they are analogous, because they are solving the similar problem of connecting to a web site to gain the information regarding he document read by the scanner. The teachings of Witschorik to use the scanner for the recognizing the document can be introduce in to the Funk's system as there is a camera numerical 18 of figure 2, and this provides a system that checks for the currency at the point of service, motivation from col. 2, lines 3-6 of Witschorik.

***Allowable Subject Matter***

6. Claims 20-22 are allowed.

**(10) Response to Argument**

Claim 1

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the instant case, With respect to claim 1, Funk discloses a method for recognizing a security document (see col. 5, lines 35-38, wherein It states that the CPU determines “recognizes” as a document be a passport “security document”), and in response, directing to a web site related to the document (see col. 5 last line to col. 6 first two lines, it states that there is network port to connect to a central computer “web site” using a network port in order to call the document information “related to the document”) as claimed. However, Funk fails to explicitly discloses a web browser, as claimed. Russell, teaches a method for connecting to a web site using the web browser (see col. 2, lines 57-62) as claimed.

It would have been obvious to one ordinary skilled in the art at the time of invention to combine the two references as they are analogous, because they are solving the similar problem of connecting to a web site to gain the information regarding he document read by the scanner. The teachings of Russell of having the URL encoded in to the text can be implemented in to the security document of the Funk as the passport does has text and the scanner of the Funk does scan the text (figure 1 numerical 12). And, motivation of the combination does come from the teaching reference of Russell from col. 2, lines 34-39.

#### Claim 2

With respect to claim 2, applicant argues that the reference fails to disclose the “substitute” image. Examine disagrees and would like to point out that the claims are

given their broadest reasonable interpretations. And, in this case, Funk discloses in col. 6, lines 1-6, it states that the information such as pictorial information read from the passport (col. 6, lines 2-3) can be displayed on a display and this pictorial information is read as the “substitute” image, as claimed.

#### Claim 3

With respect to claim 3, applicant argues that the reference fails to disclose the limitations. Examine disagrees and would like to point out that the claims are given their broadest reasonable interpretations. And, in this case Funk in col. 6, lines 4-10 states displaying the pictorial information as reads from the passport (col. 6, lines 7-8) which is read as the limitation of “presenting the supplemental information relating the document”, as claimed.

#### Claim 4

With respect to claim 4, applicant argues that the reference fails to disclose the limitations. Examine disagrees and would like to point out that the claims are given their broadest reasonable interpretations. And, in this case Funk discloses, see col. 5, lines 30-35, it states that the passport has a MRZ sections and the information read from the MRZ sections “watermark” helps to identify or recognize the passport “security document” as claimed.

#### Claim 5

The arguments of claim 1 stands as claim 5 stands or fall with claim 1.

Claim 18

With respect to claim 18, applicant argues that the reference fails to disclose the limitations of "contacting a web site that provides information concerning reproduction of the document" as claimed. Examiner disagrees and would like to point out that the claims are given their broadest reasonable interpretations. And, in this case Funk discloses the information concerning reproduction of the document, (see col. 6, 8-9, it states that the central computer "web site" determine if the passport is alter or counterfeit "information concerning reproduction") as claimed.

Claim 27

The arguments of claim 18 stands as claim 27 stands or fall with claim 18.

Claim 19

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case Gruhl teaches, web sites that provide information about counterfeiting and penalties (endnotes 11-13, page 15, the websites listed in the endnotes does such as, Fundamental facts about money at the Federal Reserve Bank

of Atlanta, give the proper use of the government issued documents and what penalties one would incur if use the counterfeit government issued documents).

It would have been obvious to one of ordinary skill in the art to direct the user of a system like Funk and Russell to a website that not only confirms the validity of document or information about counterfeiting, but also allows the user to provide the would-be counterfeiter with potential penalties for continued passing of false currency. One of ordinary skill would be motivated to look at Funk and Russell in light of Gruhl since the system of Funk is used to provide information regarding the document scanned.

Claim 23

Please see the reasons set forth in the arguments for claim 19.

Claim 24

The arguments of claim 18 stands as claim 24 stands or fall with claim 18.

Claim 28

With respect to claim 28, applicant argues that the reference fails to disclose the limitation. Examine disagrees and would like to point out that the claims are given their broadest reasonable interpretations. And, in this case Funk teaches using MRZ information areas (col. 5, lines 30-35) not steganographic data decoded using visible light. Gruhl teaches: wherein said recognizing includes decoding steganographically (imperceptibly embeds, page 3, section 2, second sentence) encoded data from visible light scan data (Gruhl is trying to solve the problems of using color copiers, page 2, Section entitled Problem), corresponding to said document( see fig 5, page 8).

It would have been obvious to one of ordinary skill in the art to use the imperceptible watermark of Gruhl in the system of Funk and Russell, as suggested by Funk (see col. 5, lines 42-50).

Claim 29

Arguments as set forth for the claims 19+23+28 applies here.

Claims 25 and 26

With respect to claims 25 and 26, applicant argues that the reference fails to disclose the limitation. Examine disagrees and would like to point out that the claims are given their broadest reasonable interpretations. And, in this case Witschorik in method of detecting counterfeit currency teaches recognizing is performed by a scanner and the by the driver software in the scanner, (see figure 1 numerical 50 the scanning devices and col. 8 lines 4-6, it states that having the techniques in the currency scanning would provide a back up, also the "driver software" is a software that helps the hardware "scanner" to work, without the driver the hardware will not work, therefore, I one has the hardware the drive is inherently there) as claimed.

It would have been obvious to one ordinary skilled in the art at the time of invention to combine the references as they are analogous, because they are solving the similar problem of connecting to a web site to gain the information regarding he document read by the scanner. The teachings of Witschorik to use the scanner for the recognizing the document can be introduce in to the Funk's system as there is a camera numerical 18 of figure 2, and this provides a system that checks for the currency at the point of service, motivation from col. 2, lines 3-6 of Witschorik.

### Commercial Success

The declaration does not provide evidence of commercial success. An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. See MPEP 716.03.

Evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition, improved performance, or some other factor. The declaration fails to establish the nexus. The method as detail by the press release in March 2004 (see page 25-26 of brief) fails to point out the method as claimed, i.e. there no factual evidence in that statement that the method claimed is the method in the press release. Also, the statement "their adoption of the technology ... of the claimed invention." merely states the opinion of the under signer of the brief and not the evidence of the commercial success as required by the MPEP.

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); In re Noznick, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

**(11) Related Proceeding(s) Appendix**

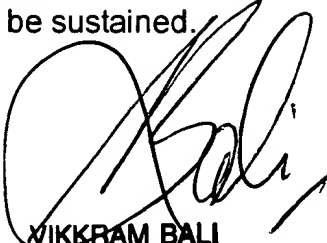
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Vikkram Bali

September 20, 2006



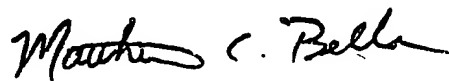
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